

REMARKS

Applicant has amended claims 3, 8, 17, 18, 21-25, 29, 30, 32, 37, 46, 47, 50 and 53 to overcome the cited section 112 problems and to more clearly define the present invention. Applicant has canceled claims 26, 28 and 52 to expedite the prosecution of the application. Review, reconsideration and allowance of the remaining claims are respectfully requested.

THE PRESENT INVENTION

The present invention concerns a combination baton and spray dispenser that can be readily employed as a baton or as a dispenser without requiring complex re-orientation or concentrated aiming. The invention includes an expandable baton having a mounted connector coupling that facilitates connection to an end of an irritant spray dispenser disposed in axial alignment with the baton. The connector coupling supports a switch mechanism readily operable by the user's thumb while grasping the connector coupling to selectively dispense spray axially from the dispenser with the baton in either its retracted or expanded positions. The switch mechanism includes a safety button selectively operable to prevent unintended actuation of the dispenser.

THE CITED ART

The Office Action has rejected claims 1-54 under 35 U.S.C. Section 103(a) as being unpatentable over Parsons (U.S. Patent No. 6,283,609) in view of Ashihara (U.S.

Patent No. 5,192,074) and further in view of Chen (U.S. Patent No. 5,446,985). Parsons teaches the use of a flashlight and baton in combination. Ashihara teaches the use of a handled nightstick type baton, and includes embodiments that either have a flashlight or a gas ejection device but does not teach the interchangeability of one for the other. Chen teaches the inclusion of a gas ejection device within a flashlight.

The Office Action states that Ashihara teaches, in Figs 13 and 14, that gas ejecting devices and illuminating devices in batons are interchangeably desirable police defensive equipment. Applicant agrees that these devices are both used as police defensive equipment but respectfully disagrees with the Office Actions assertion that this is what is being shown. In fact, those figures in no way show an interchangeability of gas for illumination but instead shows two different *nightsticks* one having a gas discharge ability the other having a flashlight. It is wrong to suggest that one device is interchangeable for the other as both devices are useful to police or other security forces but have different functions that are not necessarily related. One could not truly subdue an attacker by shining a flashlight on him nor could one light ones path with a gas spray dispenser.

Further, the baton, or nightstick, of Ashihara is not of the same type as that shown or claimed in the present invention. Ashihara does not teach an expandable and collapsible baton, but instead shows a nightstick type baton, which is a device having a fixed length. Such batons are not subjected to the forces and vibrations that are sustained by expandable batons merely in the actions of opening and closing; which forces would

wreak havoc on gas ejection devices of the prior art. The present invention is capable of using an expandable baton in part because of the connecting sleeve and specialized trigger button claimed in the present application. It would not, therefore, have been an obvious matter of replacing illumination with gas ejection as stated in the Office Action.

With respect to Chen ('985) there is no teaching in Chen with respect to the use of a dispenser, nozzle plate or orifice in a baton. The Office Action is incorrect. The Chen reference deals only with the use of gas ejection equipment with flashlights. It is again respectfully noted that a flashlight does not produce the forces that an expandable baton will produce and therefore it would not have been obvious to persons having ordinary skill in the art to use a baton instead of the flashlight of Chen. Further, the teachings of Chen require the use of the flashlight as it is a principal of Chen to provide illumination for the use of the gas dispenser. Chen states that one of its goals is to overcome the prior art where a flashlight had a gas ejection feature but that feature provided gas ejection from a side opposite the illuminating end of the flashlight. Chen teaches the use of a flashlight to illuminate the target for the use of the gas. To replace the flashlight of Chen with a baton would remove this important element of the Chen teaching and thereby remove Chen's principal of operation. As such, that modification would not be obvious to a person having ordinary skill in the art and is unacceptable. The MPEP specifically states, at Section 2143.01:

**THE PROPOSED MODIFICATION CANNOT RENDER THE
PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, *then there is no suggestion or motivation to make the proposed modification. In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). (emphasis added)

Further,

**THE PROPOSED MODIFICATION CANNOT
CHANGE THE PRINCIPLE OF OPERATION OF A
REFERENCE**

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

As noted, changing an illuminated gas ejection device for a gas ejection device having a baton attached thereto changes the principal of operation of Chen such that the Office Action's suggestion is inappropriate.

Claims 10-16 and 39-45 have been rejected because the Office Action conjectures that the use of outer plate lenses of different types are well known. Applicant respectfully disagrees and notes that the use of these plates is part of a subterfuge such that the user of the device of the present invention can keep concealed the fact that the device is a gas ejector and not a flashlight. The use of the different lenses as in the present invention would not be made obvious by the use of different lenses in the '609 patent, as suggested by the Office Action, because the '609 patent deals with flashlights

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where different lenses may be a utility choice rather than subterfuge as in the present invention. Uses for different reasons cannot be said to be obvious.

With respect to the remaining claim rejections, Applicant respectfully suggests that as the combination of Parsons, Chen and Ashihara do not teach the present invention, the use of a particular type of actuation device therefore does not remedy the deficiencies in that combination to make these claims obvious. Further, the addition of Perpoint does not overcome this deficiency.

CONCLUSION

Applicant encloses a petition for a three-month extension of time to respond, as well as a check to cover the fee for the petition. It is believed that no other fees or petitions are necessary in this reply and as a result of the amendments. The Commissioner is hereby authorized to charge any additional fee which may be required for this application under 37 C.F.R. §§ 1.16-1.18, including but not limited to the issue fee, or credit any overpayment, to Deposit Account No. 23-0920. Should no proper amount be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920. A duplicate copy of this sheet(s) is enclosed. Further, should any additional petition be required with respect to this reply and amendment, the Commissioner is respectfully requested to treat

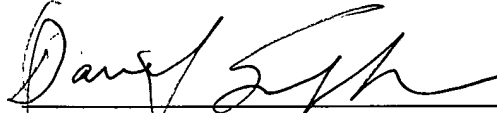
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this paper as the necessary petition or petitions and to charge the petition fee(s) to the above noted deposit account.

Applicant hereby respectfully requests reconsideration and continued examination. A sincere effort has been made to overcome the Action's rejections and to place the application in allowable condition. Applicant invites the Examiner to call Applicant's attorney to discuss any aspects of the invention that the Examiner may feel are not clear or which may require further discussion.

In view of the foregoing remarks and amendments, it is believed that the subject application is now in condition for allowance, and an early Notice of Allowance is respectfully requested.

Respectfully submitted

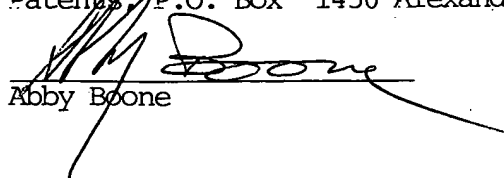


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I certify that this document is being deposited on 03/08/2005 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313.


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